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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/509,369

09/28/2004

Yasuo Suzuki

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54071

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04/19/2006

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EXAMINER

DICUS, TAMRA

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/509,369	SUZUKI ET AL.	
	Examiner	Art Unit	
	Tamra L. Dicus	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 42-89 is/are pending in the application.
- 4a) Of the above claim(s) 60-89 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 42-59 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>09-28-04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

The cancellation of claims 1-41 is acknowledged.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 42-59, drawn to a decorative sheet.

Group II, claim(s) 60-89, drawn to a production method of a molded article.

The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the special technical feature does not provide a contribution over the prior art because the special technical feature is disclosed in USPN 4,603,065 to Mori et al.

During a telephone conversation with Peter Medley on a provisional election was made with traverse to prosecute the invention of I, claims 42-59. Affirmation of this election must be made by applicant in replying to this Office action. Claims 60-89 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the

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currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 51 and 54-55 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims recite "the range" which is not clear as to what range this intends.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 42-50 and 52-53 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 4,603,065 to Mori et al.

Mori teaches a decorative sheet comprising a base member, formed from a resin material (1, FIG. 2 and associated text), having a first and a second principal surfaces opposite to each other; a decoration layer (6, FIG. 2 and associated text), provided on the first principal surface of the base member, having a pattern area representing a predetermined pattern (6, 9, 10, FIG. 2 and associated text); and a spread suppressing member (11, FIG. 1 and 4, FIG. 2 and associated text), provided in a position corresponding to the pattern area on the side of the first principal surface or on the side of the second principal surface of the base member, for

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suppressing the spreading of the pattern area of the decoration layer (same material, same ordered structure, functionality present, instant claim 1 is met). See also col. 2, lines 40-60.

Mori teaches the decorative sheet of instant claim 42, wherein the resin material is a thermoplastic resin material (col. 2, lines 20-26) (instant claims 43-44).

Mori teaches the decorative sheet of instant claim 42, wherein the spread suppressing member has a higher coefficient of thermal conductivity than a coefficient of thermal conductivity of the base member because the same materials are used, the coefficient is inherent (instant claims 45 and 50).

Mori teaches the suppressing member is of metal and overlaps the pattern area and includes a portion arranged along an outer circumference (11, FIG. 1) at col. 1, lines 40-57; col. 2, lines 40-60; col. 4, lines 60-65 (instant claims 46-49, 53).

Mori teaches the molded article comprises a molded article body (11, FIG. 1 and associated text) and the decorative sheet of instant claim 42 set forth above, and joined to a surface of the body (FIG. 1 and 2 and associated text, col. 1, lines 40-57).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 51, 54-55, and 57-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 4,603,065 to Mori et al. as applied to claim 42 above.

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Mori essentially teaches the claimed invention as set forth above, but does not teach a range as recited in instant claims 51, 54-55, and 57-58.

However, Mori does not state the thickness as recited. However, it would have been obvious to one of ordinary skill in the art to produce a thickness as claimed, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272. Thickness effects the degree of light shielding (col. 4, lines 55-60 of Mori).

Regarding claim 59, Mori teaches the molded and decorative sheet set forth above is a part of molding used especially for automobiles. Thus one having ordinary skill in the art would have modified the Mori invention to include a motor vehicle as claimed because Mori teaches the use of the sheet used on automobiles for molding, nameplates, emblems, or interior or exterior decorating of a car (col. 1, lines 45-60 of Mori).

Claim 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 4,603,065 to Mori et al. as applied to claims 42 and 56 above, and further in view of USPN 2002/0003696 A1 to Kalana.

Mori essentially teaches the claimed invention as set forth above.

Further regarding claim 59, Mori teaches the molded and decorative sheet set forth above is a part of molding used especially for automobiles while not showing a motor vehicle.

Kalana shows a motor vehicle using a molded decorative EL panel in any shape used to provide an advertisement or illumination on the car (see [0035] and 100, FIG. 1 and associated text).

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Thus one having ordinary skill in the art would have modified the Mori invention to include a motor vehicle as claimed because Mori teaches the use of the sheet used on automobiles for molding, nameplates, emblems, or interior or exterior decorating of a car (col. 1, lines 45-60 of Mori) and Kalana shows a motor vehicle using a molded decorative EL panel in any shape used to provide an advertisement or illumination on the car (see [0035] and 100, FIG. 1 and associated text of Kalana).

References of Interest

The remaining references listed on form(s) 892 and/or 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the rejection above.

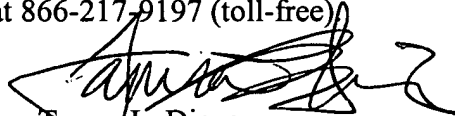
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tamra L. Dicus
Examiner
Art Unit 1774

4-4-06



RENA DYE
SUPERVISORY PATENT EXAMINER

A.U. 1774 4/14/06